

Amendment and Response
Applicant: Mark Hirst et al.
Serial No.: 10/689,464
Filed: October 20, 2003
Docket No.: 200309601-1
Title: INDICATING SYSTEM

REMARKS

Accordingly, Applicant has rewritten claim 3, 5, 15, 23 and 26 into independent form. Allowance of these claims and the claims dependent therefrom is requested.

Claim Rejections under 35 U.S.C. § 103

The Office Action relies on a single reference, Dowling, in rejecting claims 11-14, 16-22, 24, 25 and 27-40 under 35 U.S.C. 103(a). Applicants respectfully traverse.

Applicants submit that the Office Action fails to establish a *prima facie* obviousness of claim 11 because Dowling fails to teach a "fuser" as recited in claim 11. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." (MPEP 2143.03). Dowling is the only reference relied upon in this rejection. The Dowling reference fails to disclose a fuser. As such, Applicants submit the Office Action fails to establish *prima facie* obviousness of claim 11 because Dowling does not teach or suggest all of the claim elements.

Further, the Office Action essentially concedes that Dowling does not teach a fuser. ("Dowling does not specifically state that the disclosed indicating system may be provided in an imaging system that includes a fuser." Office Action, page 4, lines 5, 6). Accordingly, because the cited Dowling reference does not disclose a fuser as recited in claim 11, Applicants submit that the Office Action does not establish *prima facie* obviousness of claim 11 and request withdrawal of this rejection.

The Office Action also fails to establish *prima facie* obviousness of claim 11 on the basis that there is no suggestion in Dowling to modify Dowling to include a fuser. "In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." MPEP 2143.01. Here, Applicants submit that there is no teaching in Dowling that would appear sufficient to permit modification of Dowling to include a fuser as recited in claim 11.

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The Office Action alleges that "it would have been obvious to one of ordinary skill in the art at the time the invention was made that the indicating system of Dowling could be used in a fuser because the surfaces of a fuser can become hot and Dowling teaches that the disclosed indicating system can be used as a warning system for use with any potentially hot surface to warn operators of the hot surfaces." Applicants traverse this rationale. Dowling's recognition that the Dowling device can have different applications does not teach that the Dowling device can be modified to include a fuser as recited in claim 11. As such, Applicants traverse this basis of rejection for this additional reason.

Accordingly, because Dowling does not teach or suggest a fuser, Applicants submit that the Office Action fails to establish *prima facie* obviousness of claim 11. Withdrawal of this rejection is requested.

Claims 34 and 40 also recite a fuser and, as such, are allowable for at least the same reasons claim 11 is allowable. Withdrawal of these rejections is requested.

Applicants also traverse the rejection of claims 21 and 22 on the basis that Dowling does not disclose an "imaging system" as recited in claims 21 and 22. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." (MPEP 2143.03). Because Dowling does not teach an imaging system, Dowling does not teach all of the limitations of claims 21 and 22. Hence, the Office Action fails to establish *prima facie* obviousness of claims 21 and 22. Withdrawal of these rejections is requested.

Dependent claims 12-14 and 16-20 further define patentably distinct independent claim 11, dependent claims 24-25 and 27-33 further define patentably distinct independent claim 22, and dependent claims 35-39 further define patentably distinct independent claim 34. Accordingly, dependent claims 12-14, 16-20, 24-25, 27-33, and 35-39 are also allowable over the art of record.

CONCLUSION

Applicants believe that the present application is in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

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The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

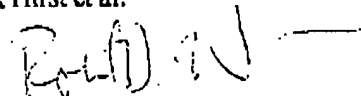
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Date

12/12/2005

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I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Alexandria, VA, on 12-13-2005 to PTO fax no. (571) 273-8300.

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